

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BENNEKER et al.
Title: CRYSTALLINE PAROXETINE
METHANE SULFONATE
Appl. No.: 09/200,743
Filing Date: 11/30/1998
Examiner: Celia C. Chang
Art Unit: 1625
Confirmation Number: 9739

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned application, for which the issue fee is being paid concurrently herewith.

As indicated on the Notice of Allowance issued April 17, 2009, the Patent Office determined that the patent was entitled to 2057 days of PTA. Applicants disagree with the Office's calculation in two respects.

I. Calculation of PTA in Letter Regarding Patent Term Adjustment

Applicants respectfully disagree with the recalculation of the PTA as detailed in the Letter regarding Patent Term Adjustment mailed on February 10, 2009. The Letter indicates that

PTA days should be granted from the date of the favorable decision by the Board of Patent Appeals and Interferences (May 25, 2004), until the date the Notice of Allowance was issued on September 19, 2008, for a total of 1,455 days of adjustment.

However, Applicants believe that the total delay by the Office began on September 30, 2001, four months after Applicants filed a response to the Restriction Requirement, and ended on September 19, 2008, with the issuance of the Notice of Allowance, which should result in an adjustment of **2,546** days. The Notice of Suspension issued on August 2, 2001 does not constitute a response, or action by the PTO, in accordance with 37 C.F.R. § 1.703(a)(2), which states:

“The period of adjustment under §1.702(a) is the sum of the following periods . . . (2) The number of days, if any in the period beginning on the day after the date that is four months after the date a reply under §1.111 was filed and ending on the date of mailing of either ***an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151***, whichever occurs first....

II. Calculation of PTA in view of *Wyeth v. Dudas*

Applicants believe that the PTA determination as indicated on the Notice of Allowance was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office’s interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of “overlap” are

limited to “periods of time . . . [that] occur on the same day.” *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays “occur on the same day.” *Id.*

III. Summary and Calculation of PTA

In view of the foregoing, Applicants have recalculated PTA for the captioned application under the court’s interpretation of the PTA statute, and have determined that, as of issuance of the Notice of Allowance on April 17, 2009, the application is entitled to a total of 2714 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

Applicants filed a Petition to Withdraw Application from Issuance on March 6, 2009. Applicants understand that once an issue date for the present application is assigned, the number of days from March 6, 2009 until the issue date of the patent will be deducted as Applicant delay from the total days of PTO delay.

Applicants therefore respectfully request that the application be accorded 2714 days PTA as of the issuance of the Notice of Allowance, with the understanding that further adjustments may occur once the patent has issued.

Specifically, 2,546 days of PTA should be accorded under 37 CFR §1.703(a)(2) due to the Office delay beginning on September 30, 2001, which was four months after the Applicants filed a response to the Restriction Requirement, and ending on the day the Notice of Allowance was issued on September 19, 2008.

Additionally, under 37 CFR §1.703(f), in view of *Wyeth v. Dudas*, an additional 168 days should be accorded for the days the pendency of the application exceeded 3 years, not including the delay under 37 CFR §1.703(a)(2), and ending on March 6, 2009, when a Request for Continued Examination was filed.

The patent is not subject to a terminal disclaimer. A terminal disclaimer was filed in the application; however, a petition to withdraw the Terminal Disclaimer was granted on April 16, 2008.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicants request further that a decision on the portion of the delay (168 days) under 37 CFR §1.703(f), in view of *Wyeth v. Dudas*, be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date _____

By _____

FOLEY & LARDNER LLP
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Telephone: (202) 295-4094
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Courtenay C. Brinckerhoff
Attorney for Applicant
Registration No. 37,288

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Respectfully submitted,

Date May 21, 2009

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By Courtenay C. Brinckerhoff

Courtenay C. Brinckerhoff
Attorney for Applicant
Registration No. 37,288

Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 091856-0111

Application Number: 09/200743

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	11/27/2000	0		
Edit Delete	Restriction Requirement	04/26/2001	150		
Edit Delete	Restriction Requirement Response Received at PTO	05/31/2001	185		
	Restriction Requirement Response Filed + 4 months	09/30/2001	307		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	03/20/2002	478		
Edit Delete	Interference Declared	10/01/2002	673		
	3 Year Period Starts	11/27/2003	1,095		
Edit Delete	Interference Decided	05/25/2004	1,275	(603)	
Edit Delete	Notice of Allowance	09/19/2008	2,853	(2546)	
Edit Delete	Issue Fee Paid	10/01/2008	2,865		
	Issue Fee Paid + 4 months	02/01/2009	2,988		
Edit Delete	Request for Deferral of Issuance received at PTO	03/06/2009	3,021	(33),(33)	
Edit Delete	Request For Continued Examination	03/06/2009	3,021	(1926) 2714	
	3 Year Period Stopped	03/06/2009	3,021		
Edit Delete	Notice of Allowance	04/17/2009	3,063		
Edit Delete	Issue Fee Paid	05/21/2009	3,097		